

In the above amendment, claims 16, 18, 21, 26, 28, 30, 31 and 32 are amended.

REMARKS

This is in response to the first Office Action on the merits mailed August 24, 2005.

Allowable Subject Matter

On page 1, item 5 of the April 4, 2005 first Office Action and in the current Office Action Summary, method claims 1-15 were indicated as allowable. Applicants appreciate the indication of allowable subject matter to the method.

Rejection under 35 U.S.C. §112

On page 2, item 2 of the August 24, 2005 Office Action, claims 30 and 32 were rejected under the written description requirement of the first paragraph of 35 U.S.C. §112. The originally filed application did cover loops in a manner that presents mirrored messages because such is inherent in embroidery. In the current amendment, however, to advance prosecution in a timely manner, claims 30 and 32 are amended to overcome this rejection. Reconsideration and withdrawal of the rejection of claims 30 and 32 under the written description requirement of 35 U.S.C. §112, first paragraph is respectfully requested.

Claim Rejections – 35 U.S.C. §103

On page 2, item 4 of the August 24, 2005 Office Action, claims 16, 18-24, 26, 28, 29 and 31 were again rejected under 35 U.S.C. §103(a) as obvious over Bissell (U.S. Patent No. 660,787) in view of Ellis (U.S. Patent No. 2,399,478), Contini (U.S. Patent No. 6,067,660) and Conrad (U.S. Patent No. 3,662,878).

The four applied references Bissell, Ellis, Contini and Conrad, alone or in combination, do not disclose or suggest an embroidered portion on a crocheted surface of a crocheted ball or object of substantially spherical shape “wherein a maximum dimension of the embroidered portion has a diameter of no more than approximately 2.25 inches and the spherical shape has a circumference of approximately 7.5’ inches” as now

recited in both rejected independent claims 16 and 21. Ellis, Contini and Conrad sew fabric to large, nearly flat crocheted objects utilizing sewing access to both front and back surfaces of the flat crocheted objects. None of these references would have lead one of ordinary skill to apply embroidery to a crocheted ball of the claimed small size. It would have been impossible to apply the embroidery of Ellis, Contini and Conrad to the crocheted fabric covered ball of Bissell because there would have been no access to the inside surface to sew the embroidery under all prior art sewing conventions at the time of the invention.

Applicants thus contend that these and the other apparatus claims to the object itself are patentable independent of the method because such construction of embroidery on a crocheted ball was not heretofore possible without the contribution of the present inventors. There was no other known way to perform direct embroidery onto a small, spherical crocheted object.

The four non-patent publications in the accompanying Information Disclosure Statement evidence the difficulty of hopping small, curved objects. A small crotched ball, such as that claimed, was previously impossible to embroider. Accordingly claims 16, 18-24, 26, 28, 29 and 31 are patentable over Bissell, Ellis, Contini and Conrad, alone or in combination.

Claims 16 and 21 recite that the embroidery portion is embroidered onto the crotched fabric. Glued on embroidery such as a Schifeli patch of the prior art does not disclose or suggest embroidering onto crotched fabric as recited. Additional reasons for patentability are cited in the Remarks of the prior response to the initial April 4, 2005 rejection over these four references.

The dependent claims contain the limitations of their corresponding independent claims and are patentable over Bissell, Ellis, Contini and Conrad for the reasons discussed above. Furthermore, the dependent claims contain additional limitations which are not taught or suggested by Bissell, Ellis, Contini and Conrad. Applicants have discovered size constraints on the initial disc relative to the further crocheted portion for holding the embroidered portion as recited in dependent claims 16 and 22. The recited maximum dimension of the embroidered portion having a diameter of no greater than about 30% of a circumference (claims 18, 30 and 31) and the recited additional crocheted rows forming sides of around 36% to around 46% of a total number of crocheted rows of the spherical crocheted object (claim 22) further describe properties of the object not subject to any method of making.

Accordingly, claims 16, 18-24, 26, 28, 29 and 31 are not in condition for allowance. Reconsideration and withdrawal of the rejection of these claims 16, 18-24, 26, 28, 29 and 31 under 35 U.S.C. §103(a) over Bissell, Ellis, Contini and Conrad is respectfully requested.

Conclusion

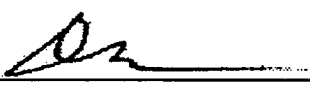
All the issues in the August 24, 2005 first Office Action have been addressed. Favorable consideration of the present application is requested. If any issues remain, the Examiner is invited to call the undersigned.

The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this communication.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 24, 2005.